

elastomer.

31. (Amended) The motor vehicle of claim 27, wherein said part is a pipe and the coating is formed on an outer surface of said pipe.

32. (Amended) The motor vehicle of claim 27, wherein said part is an O-ring having outer and inner perimeters, and a circumferential groove extending along the outer perimeter, and wherein the coating is disposed on an entire exposed surface of said O-ring except in a region of said circumferential groove.

33. (Amended) The motor vehicle of claim 27, wherein said part is a valve comprising an elastomer valve membrane, and said coating is disposed on said valve membrane.

REMARKS

Reconsideration of the patentability of the instant invention is solicited in view of the above amendments and the following comments. It is not believed that any extension of time is due with the filing of this response. However, if one is required to maintain the pendency of this application, kindly consider this to be a petition therefore. If necessary to maintain the pendency of this application, kindly consider this to be a Notice of Appeal. It is not believed that there is any fee due with the filing of this response. However, if any fee is due, kindly charge the same to the undersigned attorneys' deposit account No 07-1337

It is recognized that this application is under final rejection and that after final rejection, the examiner has wide discretion in either entering or refusing to enter amendments. In this specific case, the substantive rejections set forth in the outstanding action all rely on references that were cited for the first time in the outstanding action. The examiner has alleged that the new grounds of rejection were necessitated by the amendments that applicants submitted in response to the first office action. This position of the examiner is respectfully traversed as not being well grounded in fact.

BEST AVAILABLE COPY

Reconsideration of the amendments introduced in response to the first office action will show that these amendments were principally addressed to converting the originally filed claims to good form for United States patent practice. For example, the amendment to claim 1 only introduced the fact that the body being claimed was a non-metal and the thickness of the polytetrafluoroethylene coating. Except for that, every other element of the amended claim finds correspondence in the originally filed claim 1. In the outstanding second action, the examiner objected to both of these factors under 35 USC 112, and both have been amended in this response. None of the new references being relied on by the examiner in the final rejection, is being relied on in combination with the references relied on in the first office action.

The first rejection, paragraph 9 of the final rejection, is an anticipation rejection of original (amended) claims, based on the disclosure of the '459 patent (a reference that was newly cited in the final rejection). Yet the rejected claims are narrower than were the claims originally acted on in the first office action.

The second rejection, paragraph 10 of the final rejection, is an anticipation rejection of original (amended) claims, based on the disclosure of the '482 patent (a reference that was newly cited in the final rejection). Yet the rejected claims are narrower than were the claims originally acted on in the first office action.

The third rejection, paragraph 11 of the final rejection, is an obviousness rejection of original (amended) claims, based on the combined disclosures of the '482 and '177 (both references are newly cited in the final rejection). Yet the claims being rejected are narrower than were the claims addressed in the first office action.

The fourth rejection, paragraph 12 of the final rejection, is an obviousness rejection of original claim 10 (amended), based on the combined disclosures of the newly cited '482 patent and the previously cited '444 patent. Note should be taken that the single rejected claim, 10 only added the fact that the part being coated was a tube. This claim too is narrower than was the original claim 10.

The fifth rejection, paragraph 13 of the final rejection, is an obviousness rejection of claim 16, a claim newly submitted in the response to the first action, based upon the combined disclosures of the newly cited '482 patent and the newly cited Alger publication. It is conceded that claim 16, the claim rejected in this paragraph, was newly submitted in response to the first action.

The sixth rejection, paragraph 14 of the final rejection, is an obviousness rejection of original claims (amended), based on the disclosures of the combination of two newly cited references (the 048 and the '482 references).

It is clear, therefore, that only amended dependent claim 10 was finally rejected over the disclosure of a reference that had been cited in the first action. Only newly submitted claim 16 was finally rejected the first time that it was submitted. Only one reference that was cited in the first office action was used to reject only one claim, 10. The rest of the citations and rejections are all new, yet their application has made the rejection final in the first instance. THAT IS SIMPLY NOT FAIR. In other environments, that would be called sandbagging. It is only fair that, if the examiner wants to rely on new art, he should give applicants the opportunity to respond to these rejections, not close him out before he has had a chance to respond.

Secondly, it is noted that the examiner has rejected certain claims under 35 USC 112. Many of the amendments offered in the instant response are directed specifically to these rejections. To make these rejections and not permit applicant to amend the offending claims to obviate them is SIMPLY NOT FAIR.

It is therefore urged that the examiner reconsider the finality of the outstanding action and withdraw the same. It is believed that the instant amendments obviate all of the rejections that have been entered by the examiner and that this application is in condition for allowance.

The '459 patent discloses a coating material that is electrically conductive. It is a fluorinated polymer that contains carbon fibrils to make it conductive. The fluorinated polymer is not the same as the polytetrafluoroethylene that the instant claims require. The examiner has specifically pointed to column 4 for support for his contention that this reference discloses every

material aspect of the rejected claims. However, that is not true. There is no disclosure in the reference of a polytetrafluoroethylene polymer. There are disclosures of ethylene-tetrafluoroethylene copolymers. There are disclosures of tetrafluoroethylene-hexafluoropropene-vinylidene fluoride terpolymers. However, there is no disclosure of a polytetrafluoroethylene polymer. Therefore, this reference does not anticipate the rejected claims.

Further, there is no disclosure in this reference of the property of polytetrafluoroethylene polymer for which it is employed in the instant invention. There is no disclosure that this specific polymer, or the co or ter polymers disclosed in the reference as having the ability to seal a surface against the transmission of hydrocarbons therethrough. Thus, not only does this reference not anticipate the claims of this application, it does not render the instant invention obvious either.

The '482 reference, too, does not disclose a coating of a polytetrafluoroethylene polymer for any purpose. It discloses elastomers of a terpolymer of vinylidene fluoride-hexafluoropropylene-tetrafluoroethylene. Thus, this reference too does not support an anticipation rejection. Further, it does not support an obviousness rejection either because it does not disclose that a polytetrafluoroethylene polymer seals plastic or rubber surfaces against the transmission of hydrocarbons therethrough.

Similarly, the obviousness rejections cannot stand close scrutiny. The '177 patent discloses a multilayered corrosion resistant article that uses a carbon filled fluoro elastomer as a top coating. There is no disclosure of a polytetrafluoroethylene polymer acting as a block against the transmission of hydrocarbons through a substrate being protected by the polymer. That is the essence of this invention. No reference of record discloses that. Therefore, no reference can be said to either anticipate or render obvious the instant claimed invention. In this regard, it should be noted that the instant polymer is not claimed *per se*. This polymer is old. It has been around for many years. It has been coated on innumerable substrates. However, it is always being used for its non-adherent properties. It is a non stick surface. That, however, tells us nothing about the ability of this polymer to retard or prevent the passage of hydrocarbons therethrough, and that is the discovery upon which this invention is based.

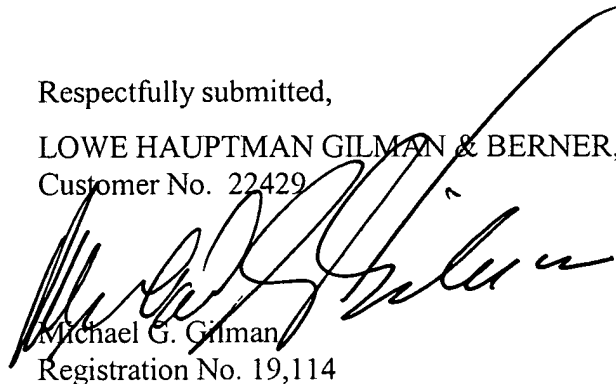
Serial No. 09/819,821

It is urged that the examiner reconsider the positions he has taken and closely compare the true complete disclosures of the references with the features of the claims. Every claim in this application is directly related to the newly discovered property of polytetrafluoroethylene polymer, that is its ability to prevent or retard the passage of hydrocarbons therethrough. This is an unexpected property. As such, it is entitled to support the patentability of the instant claims. Therefore, the instant claims should be allowed.

Respectfully submitted,

LOWE HAUPTMAN GILMAN & BERNER, LLP

Customer No. 22429

A large, stylized handwritten signature in black ink, likely belonging to Michael G. Gilman, is written over the typed name and registration number.

Michael G. Gilman
Registration No. 19,114

1700 Diagonal Road,
Suite 300
Alexandria, VA 22314

Voice(703) 684-1111
(703) 518-5499 Facsimile

Docket NO: 713-417

Date: March 10, 2003
MGG/vgg

BEST AVAILABLE COPY